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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------|-------------|----------------------|---------------------|------------------|
| 10/016,071 | 12/05/2001 | James W. Coiner | 47501/VGG/C614 | 6970 |
| 23363 | 7590 | 08/17/2004 | EXAMINER | |
| CHRISTIE, PARKER & HALE, LLP | | | LOCKER, HOWARD J | |
| PO BOX 7068 | | | ART UNIT | |
| PASADENA, CA 91109-7068 | | | PAPER NUMBER | |

1661

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016071

Applicant(s)

Coiner

Examiner

Howard J. Locker

Group Art Unit

1661

The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on June 1, 2004
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ The claim is ~~is~~ pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ The claim is ~~is~~ rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The following is a quotation of section (a) of 37 CFR 1.163:

“(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.”

The following is a quotation of the first paragraph of 35 U.S.C. 112:

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor in carrying out his invention.”

In plant applications filed under 36 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

“No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.”

The following is a quotation of the second paragraph of 35 U.S.C. 112:

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.”

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

“The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.”

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known varieties and antecedents.

A. Relative to coloration of new wood, the information in the specification should be reviewed for accuracy and amended as necessary. The present color designation would look to account for only the anthocyanin blush (if/when present).

B. Relative to prickles/thorns as recited at page 5 of the specification the size dimensions set forth do not appear to account for the large prickles in a reasonable manner. Additionally, the recitation “no localized location” should be clarified, as what is intended or encompassed by same is not clear.

C. That the peduncle is properly characterized as being “smooth” in nature does not appear to reasonably correspond to the plant as illustrated, wherein the peduncle looks to bear numerous acicular appendages.

D. That the blooms are always borne singly as is set forth in the specification does not appear to reasonably correspond to the plant as illustrated, wherein a flowering stem with multiple buds (see originally presented photographic illustration) is set forth.

E. The information presented at pages 8 and 9 should be reviewed and amended as necessary so as to clarify what was intended. It would appear that the information currently set forth at page 9 should be relocated to appear after line 1 of page 8.

F. The color designations set forth in the specification relative to petal coloration (lower surface) do not reasonably correspond to the plant as illustrated, either in the originally filed photographic illustration or that filed June 1, 2004). Specifically, the lower petal surfaces illustrated would look to be more properly designated as yellowish at the basal portion and as orange or orange-red from the mid-portion outward to the petal edge (similar in nature to the upper petal surface), rather than being a consistent yellow coloration as the color designations currently set forth in the specification would suggest. Correction and/or clarification is necessary. Perhaps clarification/rewriting of the language at the last four lines of page 6 of the specification would assist in clarifying this issue, wherein the specification appears to be stating that the bloom is characterized by a markedly different single coloration on the upper surface as compared to the lower surface, with the illustrated blooms looking to be very similar re upper and lower petal surface coloration.

While such does not appear to be the case from the record at present, should the source of the noted discrepancy lie in the submitted photographic illustration, it would be necessary for applicant to file a substitute therefor (see 37 CFR 1.165(a) and 1.165(b)).

If, upon review, the bloom color designations set forth in the specification are determined to be correct, it would also be necessary for applicant to amend the generic bloom color description in the written description and abstract (and claim should such be set forth therein) so as to accurately account for the bicolor nature of the bloom (i.e. "orange and yellow bicolor", or similar).

G. If additional information is available relative to petal size (i.e. characteristic length and width), such should be imported into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

Applicant should carefully review and address each of the above, and should review the instant disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant, for the reasons advanced in paragraph 1 above.

3. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

4. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

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5. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew Wang, can be reached at 571-272-0811.

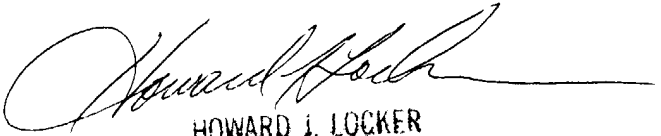
Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is: 703-872-9306.

Howard J. Locker/hjl

August 12, 2004


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT : 2662